

Application no. 09/006,777
Amdt. dated February 26, 2004
Reply to Office Action of November 26, 2003

REMARKS / ARGUMENT

A. INTRODUCTION

In the office action dated November 26, 2003, claims 23-32 were rejected: claims 23-26, 28-30 being rejected under 35 U.S.C. § 102(b) in view of U.S. patent no. 5,448,559 to Hayter *et al.* (hereafter "Hayter"); and claims 27, 31, 32 being rejected under 35 U.S.C. § 103(a) based on Hayter in view of U.S. patent no. 5,497,375 to Hluchyj *et al.* (hereafter "Hluchyj").

B. REJECTION UNDER 35 USC § 102

Applicant respectfully submits that claims 23-26, 28-30 of the present application are patentably distinguishable over Hayter in that Hayter fails to disclose one or more limitations taught and claimed in the several embodiments of the present invention. Claim 1 recites, *inter alia*: "wherein ... the output controls are arranged to monitor the backlog of buffered data units for delivery to their associated output ports ... and, if the backlog reaches a particular level, to enforce a rate limitation against additional data units for delivery to their associated output ports, wherein the additional data units in violation of the rate limitation are filtered by the rate filter." In this manner, the output may efficiently regulate the data coming to the port up to the maximum bandwidth of the port.

In contrast to the present invention, the Hayter discloses a "queuing arrangement" that responds to the bandwidth request received during periods when there is no available bandwidth capacity by subsequently releasing bandwidth in a predetermined order when capacity becomes available. Therefore, Hayter fails to disclose or suggest the embodiment of the present invention as claimed in claim 23. Independent claims 55, 63, 77, and 84 each include a similar feature and are therefore patently distinguishable for the reasons described above.

C. REJECTION UNDER 35 USC § 103

With respect to Examiner's rejection of claims 27, 31, and 32 under 35 USC § 103 in view of Hayter and Hluchyj, Applicant respectfully asserts that these claims are allowable because

Application no. 09/006,777
Amdt. dated February 26, 2004
Reply to Office Action of November 26, 2003

there is no motivation to combine these references. Although Examiner has stated that one skilled in the art would be motivated to combine references in order to "monitor a sustained cell rate and an associated burst tolerance for each connection" (office action, page 5), Examiner has merely stated a problem to be solved in terms of the solution/benefit provided by the present application, without specifically indicating the motive to combine Hayter with Hluchyj. Regrettably, Applicant has no alternative but to presume that Examiner has relied on impermissible hindsight in order to articulate the solution provided by the present application to a very general problem unsolved in the prior art. Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 45 USPQ 2d 1977, 1981-82 (Fed. Cir. 1998) (defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness). Applicant respectfully requests that Examiner demonstrate where in the prior art there is some teaching or suggestion to make the claimed combination using the cited references or other pertinent art. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (Patent Office must "identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them").

D. NEW CLAIMS

In the present response, Applicant has introduced new claims 55-96, which are consistent with the previously presented claims 1-5, 7-16, 18-22, and 33-54, which were previously canceled in *reliance* on the previous allowance and not for reasons related to patentability. If one or more claims from the newly introduced set of claims is found unallowable, Applicant respectfully requests that the action NOT be made final so that Applicant may respond to the grounds for rejection.

With respect to the previous grounds for rejection in the office action dated June 20, 2003, the invention previously embodied in claims 1-5, 7-16, 18-22, 33-54, which are now presented in claims in claims 55-96, are patently distinguishable from U.S. patent no. 5,444,706 to Osaki (hereafter "Osaki") in view of U.S. patent no. 5,754,529 to Heiss (hereafter "Heiss") because these patents fail to disclose or suggest a rate filter adapted to filter data units before they are buffered in order to prevent their being stored in the output data stores. In contrast to the

Application no. 09/006,777
Amdt. dated February 26, 2004
Reply to Office Action of November 26, 2003

present invention, Osaki discloses a discard processor 52 that merely filters packets from the queue at the output buffer, which requires that the packet discard memory be re-written (col. 8, lines 33-39).

E. CONCLUSION

For all the forgoing reasons, Applicant submits that the present invention is patently distinguishable from Hayter and Hluchy either alone or in combination. Accordingly, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Should there be any fees for this action, your office is authorized to draw from the firm deposit account number 02-3979. Should you have any questions, or identify any problem, I would appreciate a telephone call so that this matter may be resolved promptly.

Respectfully submitted,

Michael Blaine Brooks, PC

By:



Andrew S. Naglestad
Reg. No. 47,814
5010 No. Parkway Calabasas
Suite 104
Calabasas, CA 91302
Tel.: (818) 225-2920 ext. 202